

REMARKS

In response to the withdrawal of the allowance of the parent application, Applicants hereby file this continuation application and intend to abandon the parent application.

Referring to the obviousness rejections, 35 U.S.C. §103(c) provides that subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), (g) of §102, shall not preclude patentability under §103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The O'Toole reference and the claimed invention were subject to an obligation of assignment to the same entity and the O'Toole reference qualifies as prior art under subsection (e) of §102. Accordingly, the O'Toole reference may not be properly used in support of an obviousness rejection of the pending claims.

Applicants have amended the claims herein consistent with the status of the claims which were examined in the Office Action dated November 25, 2002 of the parent application.

In the Office Action dated September 30, 2003 (hereinafter the "Office Action" or "Action"), claims 1-2, 4, 8-9, 11-12, 17-18, 38, and 44 stand rejected under 35 U.S.C. §103(a) for obviousness over U.S. Patent No. 5,649,296 to MacLellan et al. in view of U.S. Patent No. 5,512,910 to Murakami. Claims 5-6, 14-15, 19-20, 22, 24, 41-43, and 46-49 stand rejected under 35 U.S.C. §103(a) for obviousness over MacLellan et al. and Murakami, further in view of U.S. Patent No. 6,130,602 to O'Toole et al. Claim 7 stands rejected under 35 U.S.C. §103(a) for obviousness over MacLellan et al., Murakami, and O'Toole and further in view of U.S. Patent No. 5,023,866 to De Muro. Claims 10, 16, and

21 stand rejected under 35 U.S.C. §103(a) for obviousness over MacLellan et al. and Murakami, in view of U.S. Patent No. 6,177,872 to Kodukula et al. Claim 25 stands rejected under 35 U.S.C. §103(a) for obviousness over MacLellan et al., Murakami, O'Toole and Kodukula et al.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to claim 1, it was stated in the Office Action that antenna 401 of MacLellan is substantially tuned to first and second different frequency bands. Applicants disagree for at least the following compelling reasons.

In support of the rejection, page 2 of the Action stated that frequency carriers 501, 502 of Fig. 5 are used for frequency shift keying modulation communication through antenna 401. Such teachings fail to disclose or suggest the claimed antenna substantially tuned to first and second frequency bands. Initially, **Applicants have failed to uncover any teachings in MacLellan regarding tuning of antenna 401, let alone tuning to first and second different frequency bands as claimed.** Further, the teachings relied upon by the Examiner fail to disclose or suggest the antenna as claimed. More specifically, MacLellan is directed towards a backscatter modulation system. Signals from sources 501, 502 are merely utilized to modulate the signal outputted from the interrogator to implement outputting of signals from the tag to the interrogator. The interrogator of MacLellan outputs a single signal having a single carrier frequency as is made clear by the teachings of cols. 3, lines 17-25 and lines 37-38 and col. 4, lines 61-65. This signal having a single carrier frequency is used to implement forward communications to the tag and return communications from the tag by backscatter modulation using the sources 501, 502.

Accordingly, MacLellan is silent regarding the tuning of the antenna 401 and MacLellan is only directed towards communications of signals of a single carrier frequency. The signals from sources 501, 502 are not transmitted but are only used to implement backscatter modulation. MacLellan is absolutely devoid of any teaching or suggestion of antenna 401 being tuned to first and second frequency bands as claimed.

Any interpretation of the antenna 401 being tuned to different frequency bands is contrary to the express teachings of MacLellan which provides full duplex communications using the carrier signal having a single frequency. Col. 4, lines 62-65 make clear the same radio signal source 201 provides a signal of one carrier frequency which is used in the transmit chain and return chain which means the demodulation is *done using Homodyne detection which provides advantages in that it greatly reduces phase noise in the receiver circuits*. Only signals of a single carrier frequency are communicated to utilize Homodyne detection and the associated advantages thereof. MacLellan fails to disclose or suggest antenna 401 tuned to different frequency bands any interpretation that MacLellan teaches antenna 401 tuned to different frequency bands is contrary to the express teachings of MacLellan. Limitations of claim 1 are not taught nor suggested by MacLellan and claim 1 is allowable.

Further, for a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed.).

MacLellan clearly is directed towards communications of signals having a single carrier frequency. Accordingly, there is absolutely no motivation to look to Murakami or other references for teachings regarding communication of signals having different carrier frequencies. The only motivation improperly results from the teachings of Applicants' disclosure. The motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. See, e.g., *Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). There is no motivation and claim 1 is allowable for this additional reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claim 10, it is positively recited that the antenna includes an impedance reduction coupler. The Office Action on page 6 states that it is obvious to combine the impedance reduction coupler of Kodukula "for improved communication." Such bald, conclusory motivation fails to provide the requisite motivation to combine the teachings of Kodukula. More specifically, the Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective

teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth rationale on which it relied. Statements set forth in the present Office Action are akin to the alleged motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings. The 103 rejection of claim 10 is improper without the proper motivation and Applicant respectfully requests allowance of claim 10 in the next action.

According to the motivational rationale presented in the Office Action, any teachings of a secondary reference may be combined with the teachings of a primary reference if an improvement is provided. Applicant submits the *Lee* case clearly illustrates such an interpretation is improper, conclusory, and not in compliance with the MPEP for establishing a proper *prima facie* case of obviousness. The mere fact that references *can*

be combined or modified does not render the resultant combination obvious *unless the prior art also suggests the desirability of the combination*. MPEP §2143.01 citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is no motivation and claim 10 is allowable for this additional reason.

Referring to claim 11, MacLellan is directed towards an arrangement wherein uplink and downlink signals of a single carrier frequency are communicated. MacLellan fails to disclose any antenna arrangements configured to communicate at a plurality of substantially resonant frequencies as defined in claim 11. Further, there is no motivation to look to other teachings regarding an antenna tuned to plurality of substantially resonant teachings in view of the usage of a single carrier frequency in MacLellan. Accordingly, positively-recited limitations of claim 11 are not shown nor suggested by the prior art and claim 11 is allowable for at least this reason.

The claims which depend from independent claim 11 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 18, MacLellan is directed towards an arrangement wherein uplink and downlink signals of a single carrier frequency are communicated. MacLellan fails to disclose any antenna arrangements configured to electromagnetically communicate having a return loss less than or equal to approximately -9 dB at a plurality of frequencies as defined in claim 18. Further, there is no motivation to look to other teachings regarding an antenna having a return loss less than or equal to approximately -9 dB at a plurality of frequencies in view of the usage of a single carrier frequency in MacLellan. Accordingly,

positively-recited limitations of claim 18 are not shown nor suggested by the prior art and claim 18 is allowable for at least this reason.

The claims which depend from independent claim 18 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Claim 22 was rejected over O'Toole in the Office Action. O'Toole does not qualify as prior art and claim 22 is allowable for at least this reason.

The claims which depend from independent claim 22 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Claim 38 recites providing a *remote communication device having an antenna substantially tuned to first and second different frequency bands*. MacLellan is directed towards a communication system wherein signals of a single carrier frequency are communicated. MacLellan fails to disclose any antenna arrangements substantially tuned to first and second different frequency bands as defined in claim 38. Further, there is no motivation to look to other teachings regarding an antenna substantially tuned to first and second different frequency bands in view of the usage of a single carrier frequency in MacLellan. Accordingly, positively-recited limitations of claim 38 are not shown nor suggested by the prior art and claim 38 is allowable for at least this reason.

The claims which depend from independent claim 38 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 44, MacLellan is directed towards an arrangement wherein uplink and downlink signals of a single carrier frequency are communicated. MacLellan fails to disclose providing a device having an antenna configured to communicate at a plurality of resonant frequencies as defined in claim 44. Further, there is no motivation to look to other teachings regarding an antenna tuned to plurality of resonant teachings in view of the usage of a single carrier frequency in MacLellan. Accordingly, positively-recited limitations of claim 44 are not shown nor suggested by the prior art and claim 44 is allowable for at least this reason.

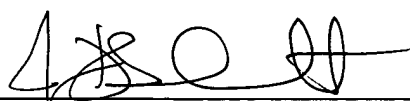
The claims which depend from independent claim 44 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants hereby add new claims 63-80 which are supported at least by pages 14-17 and Figs. 3-8 of the originally filed specification.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 3/1/04

By: 
James D. Shaurette
Reg. No. 39,833